

**REMARKS**

Claims 1-21 are pending in the present application. By this Reply, Applicant has amended claims 1, 2, 13 and 14. Accordingly, claims 1-21 remain at issue.

The Examiner rejected claims 13-15 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,587,184 issued to Wursch et al. (“Wursch”). The Examiner also rejected claims 1-5, 9, 11 and 16-19 under 35 U.S.C. §103(a) as being unpatentable over Wursch in view of U.S. Patent No. 35,539,990 issued to Le (“Le”). Additionally, claims 10 and 12 were rejected under 35 U.S.C. §103(a) as being unpatentable over Wursch in view of Le, and further in view of U.S. Patent No. 6,499,219 issued to Wightman (“Wightman”). Applicant respectfully traverses these rejections.

In view of the Amendments and Remarks herein, Applicant believes the present application is in condition for allowance and respectfully requests notice of same.

**Rejection of Claims 13-15 under 35 U.S.C. §102(e)**

The Examiner rejected claims 13-15 under 35 U.S.C. §102(e) as being anticipated by Wursch. In view of the current amendments, Applicant respectfully traverses this rejection.

Applicant has amended claim 13 to include the recitation that the auxiliary handle has “a laser generator for projecting a visible fanned laser beam in a common plane with a central axis of the chuck.” (Emphasis added.) Additionally, Applicant has amended claim 14 to include the recitation that the “auxiliary handle comprising a handle grip and a first laser generator that projects a visible fanned laser beam in a common plane with a central axis of the drill chuck.” (Emphasis added.) Support for this amendment can be found at page 5, lines 24-31; page 6, lines 14-22; and FIGS. 2, 4 and 8. Thus, no new matter has been added.

As disclosed in the Background of the Invention section of Wursch, the entire premise of the Wursch invention is that in various tasks, it is necessary to use a tool at a specific “set-down point” and it is useful to determine this “set distance” and utilize it as a reference point:

“In routine tasks, in particular, in the construction industry, the set-down point of a tool, in a sequence of work operations, frequently has, in the line of travel of the tool, an absolute or incrementally set lateral distance to a reference point, such as, for example, a wall, edge, ceiling, floor or any other structural part running

parallel to the line of travel of the tool. In such cases, either each of these set-down points is marked by the user in a preparatory work step, or a temporary measuring aid, such as a straightedge, is used by the operator between each work step.” (Col. 1, lines 10-20.)

Wursch, specifically discloses a “positioning aid for definite placement, of a forward-advanced tool of a hand tool device, such as a drill hammer.” (Col. 1, lines 6-8.) In order to provide for “definite placement,” Wursch teaches that a distance measuring system is necessary:

“a positioning aid mountable on a hand tool device driving a tool, in a line of travel, on the work piece, [that] comprises at least one **non-contacting distance measuring system with a distance measuring sensor for measuring the distance from the distance measuring sensor to an at least diffusely reflecting object along a line of measurement.**” (Col. 1, lines 50-56.) (Emphasis added.)

More specifically, Wursch discloses:

“a laser optical distance measuring system 4. The measuring system 4 comprises a distance measuring sensor 5 having three laser diodes for measuring the distance E from the distance measuring sensor 5 to a reflecting object 6, along three lines of measurement M, M’, M”, each perpendicular to each other, in the form of a tripod, oriented to the X, Y and Z axes of symmetry of the hand tool device 3.” (Col. 3, liens 44-51.)

Wursch does not disclose, teach or suggest Applicant’s claimed invention of an auxiliary handle for a tool that has “a laser generator for projecting a visible fanned laser beam in a common plane with a central axis of the chuck.” Instead, Wursch teaches that it is necessary to know the distance from a reference structure with exact precision such that a known set-down point can be identified. Accordingly, projecting a visible fanned laser beam from Wursch would add nothing to its invention, and more importantly, Wursch constructively teaches away from the device of the claimed present because it utilizes laser beams to project a laser point to a surface in order to identify a “set-down point.”

In order for a reference to act as a § 102 bar to patentability, the reference must teach each and every element of the claimed invention. Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 771 (Fed. Cir. 1983). As shown above, the Applicant respectfully submits that Wursch does not disclose each and every element of claims 13-15 (i.e., n auxiliary handle for a tool that has “a laser generator for projecting a visible fanned laser beam in a common plane with a central axis

of the chuck”), and as such claims 13-15 are not anticipated by Wursch. Accordingly, the Applicant respectfully asserts that amended claims 13-15 are patentable as presently submitted.

Rejection of Claims 1-5, 9, 11 and 16-19 under 35 U.S.C. §103(a)

The Examiner rejected claims 1-5, 9, 11 and 16-19 under 35 U.S.C. §103(a) as being unpatentable over Wursch in view of Le. Applicant respectfully traverses this rejection.

The Examiner acknowledged that Wursch does note disclose a first laser generator producing a fanned laser beam and a sub-handle with a second laser generator producing a fanned laser beam in a common plane with the central axis of the collar. However, the Examiner stated that Le teaches first and second lasers to produce fan shaped beams projected on intersecting walls. Thus, the Examiner concluded that it would have been obvious to one of ordinary skill in the art at the time of the invention to make the laser of Wursch fan shaped as taught by Le, and to include a sub handle with a second laser generator to produce a second fan shaped beam on Wursch. Applicant respectfully traverses this rejection.

As shown below in more detail, the Examiner’s rejections are improper for at least three reasons: (1) the Examiner has failed to present a *prima facie* case of obviousness; (2) the Examiner has improperly used hindsight gained through Applicants’ invention to arrive at the present rejections; and, (3) notwithstanding that the Examiner has failed to present a *prima facie* case of obviousness and has improperly utilized hindsight in the present rejection, the references cited by the Examiner do not disclose or suggest each of the limitations of the claims and as such, the claims are patentable over the cited references. Thus, the rejection of claims 1-5, 9, 11 and 16-19 under 35 U.S.C. §103(a) is improper.

First, it is the burden of the Patent and Trademark Office to establish a *prima facie* case of obviousness when rejecting claims under 35 U.S.C. §103. In re Reuter, 210 USPQ.2d 249 (CCPA 1981). To establish a *prima facie* case of obviousness, three basic criteria must be met: first, there must be some suggestion, incentive or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and third, the prior art references must teach or suggest all the claim limitations. See In re

Geiger, 815 F.2d 686, 688 (Fed. Cir. 1988). Obviousness cannot be established by combining the teachings of a reference to produce the claimed invention, absent some teaching or suggestion supporting the combination of the references. ACS v. Montefiore Hospital Systems, Inc., 221 USPQ 929, 933 (Fed. Cir. 1984). Furthermore, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the Applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ.2d 1438 (Fed. Cir. 1991).

Here, as explained in detail above, Wursch teaches a “distance measuring system” that accurately determines the distance from the two reference surfaces, such as a wall, ceiling or floor, for developing a specific “set-down point” that is a “set distance” to the reference surfaces:

“In routine tasks, in particular, in the construction industry, the set-down point of a tool, in a sequence of work operations, frequently has, in the line of travel of the tool, an absolute or incrementally set lateral distance to a reference point, such as, for example, a wall, edge, ceiling, floor or any other structural part running parallel to the line of travel of the tool. In such cases, either each of these set-down points is marked by the user in a preparatory work step, or a temporary measuring aid, such as a straightedge, is used by the operator between each work step.” (Col. 1, lines 10-20.)

Wursch requires exact set down points developed by distance measuring devices. Thus, there is no need in Wursch (and hence a lack of motivation for modifying the tool disclosed in Wursch) for projecting a fanned laser beam in a common plane with the central axis of the collar, as claimed by the present invention.

The Le reference merely discloses “an optical leveling, plumbing and angle-calibrating instrument” that emits a laser light “whereby the laser light plane will projectively intersect an objective wall to form a straight line of optical image, serving as a reference line for leveling or plumbing use.” (Le at Col. 1, lines 23-37.) Further, Le utilizes gravity to self-level its device. As shown in the figures of Le, the device is connected to a frame, often in the middle of a room, which through gravity self-levels itself, and then it projects lines outwardly that can be used as level or plumb lines. Le does not disclose or suggest projecting a fanned laser beam in a common plane with the central axis of the collar, as claimed by the present invention.

Based on the disclosures of the two references, the Applicant respectfully submits that there is no suggestion or motivation to combine Wursch with Le. The two inventions set out to

resolve entirely different problems and have very different applications (Wursch measures distances, and Le projects level lines). Moreover, it would be improper to add the teachings of Le to Wursch because the addition of level lines would assist in the objective of the invention disclosed in Wursch, i.e., to determine exact set down points. Thus, Applicant respectfully asserts that the Examiner has improperly used hindsight (i.e., the teachings of Applicant's invention) to obtain the combination. Accordingly, the Applicant respectfully submits that since there is no teaching or suggestion to combine the disclosures of Wursch and Le, the Examiner has failed to present a *prima facie* case of obviousness. For this reason the Applicant respectfully submits that this rejection is improper and should be withdrawn.

Additionally, the Federal Circuit has clearly ruled that when the modification of a disclosure would destroy the intended function of the device disclosed, the modification is improper. In re Fritch, 972 F.2d 1260, 1265 n.12 (Fed. Cir. 1992) ("A proposed modification [is] inappropriate for an obviousness inquiry when the modification render[s] the prior art reference inoperable for its intended purpose.") Applicant respectfully submits that the intended function of the references is vastly different such that combining and modifying the references as proposed by the Examiner would render the combination inoperable. For example, the Examiner states that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the laser or Wursch et al. ('184) fan shaped as taught by Le to produce an alignment line on the workpiece during use of the device." This would clearly defeat the purpose of Wursch and make Wursch inoperable for its intended purpose. Wursch requires the measurement of a distance from a specific surface. If a fan shaped line were projected by Wursch the user would not know what surface the distance was being measured from, i.e., the wall may not be flat, it may have a corner near, it may have projections extending therefrom, etc., such that a fan shaped line extending from Wursch would render the invention useless and thereby destroy the intended function of the device. Accordingly, the Applicant respectfully submits Claims 1-5, 9, 11, and 16-19 are patentable since the Examiner has failed to present a *prima facie* case of obviousness.

Finally, since Wursch nor Le teach projecting a fan shaped laser beam in a common plane with the central axis of the collar to create an alignment line on a workpiece, even if the Examiner's combination of Wursch and Le were proper, it would not result in the claimed

invention. Thus, the Applicant respectfully suggests that Claims 1-5, 9, 11 and 16-19 are patentable over Wursch and Le.

Rejection of Claims 10-12 under 35 U.S.C. §103(a)

The Examiner rejected claims 10-12 under 35 U.S.C. §103(a) as being unpatentable over Wursch in view of Le, and further in view of Wightman. Applicant respectfully traverses this rejection.

Similar to above, the Applicant respectfully asserts that the combination of Wursch, Le and Wightman is improper. Wightman discloses bubble levels. Le, however, discloses a self-leveling device, and as such bubble levels would be entirely useless to the device of Le. Similarly, Wursch discloses a distance measuring device for developing a set-down point from a variety of surfaces, and thus bubble levels are entirely useless to this device. Thus, there is no suggestion, incentive or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine the reference teachings. For these reasons the Applicant respectfully asserts that claims 10-12 are patentable since the Examiner has failed to present a *prima facie* case of obviousness with respect to claims 10-12.

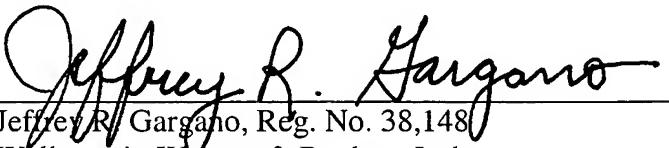
In addition, just as Wursch and Le fail to disclose or suggest the claimed “projection of a fan shaped laser beam in a common plane with the central axis of the collar,” so does Wightman. Thus, the combination of Wursch, Le, and Wightman fails to result in the claimed invention.

**CONCLUSION**

In view of the amendments made herein and the foregoing remarks, it is submitted this application is in condition for allowance. Such action is respectfully requested. Further, the Examiner is requested to contact the undersigned if the Examiner has any questions concerning this Response or if it will expedite the progress of this application.

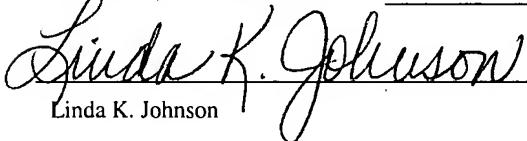
Respectfully submitted,

Date: 12-20-04

  
Jeffrey R. Gargano, Reg. No. 38,148  
Wallenstein Wagner & Rockey, Ltd.  
311 South Wacker Drive, 53<sup>rd</sup> Floor  
Chicago, Illinois 60606-6630  
312.554.3300

**CERTIFICATE UNDER (37 C.F.R. § 1.8a)**

I hereby certify that this correspondence is, on the date shown below, being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Mail Stop Amendment, Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on. December 20, 2004.

  
Linda K. Johnson